

Appl. No. 10/786,639  
Reply to Office Action dated March 29, 2005  
Page 4

### REMARKS/ARGUMENTS

Reconsideration and re-examination of amended Claim 1, 2 and 3 is respectfully requested. The Claims 1-3 were rejected under 35 U.S.C. § 102 as being anticipated by WO 02/079670 A2 issued to Ziemer. The Claims were also rejected under 35 U.S.C. § 112. The Claims have been amended to provide a more clear definition of the invention and are believed to comply with 35 U.S.C. § 112.

Applicants note that the nature of the showing required to support a rejection for anticipation under 35 USC 102 is clearly established in the case law; see, for example, Schroeder v. Owens-Corning Fiberglas Corp., (CA9 1975) 185 USPQ 723. At page 725, the court stated:

"An invention is said to be anticipated only if another invention already known or used is identical in substance. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a single prior art reference there is no anticipation."

The Examiner has suggested that Ziemer (FIG 13A) has six torque transmitting mechanisms which can be selected from elements A, B, C, D, E, D', and A' to produce ten forward speed ratios and one reverse ratio. The Examiner then suggests the selection of elements E, B, D, C, D', and A' as the torque transmitting mechanisms to be used as torque transmitting mechanisms one through six. The elimination of element A by the Examiner is noted. However a brief review of the truth table in Figure 13B makes it clear that the omission of element A results in the elimination of forward speeds 5 through 8 resulting in only six forward speeds. The elimination of any of the other torque transmitting mechanisms results in the reduction of the number of ratios available. One skilled in the art will recognize the need for all seven of the torque transmitting mechanisms to provide the ten forward ratios and one reverse ratio set forth in FIG. 13A of Ziemer.


In further analysis, the Examiner suggests that planetary gear sets NS1 and NS2 are a single gear set. However this does not agree with the disclosure of Ziemer. In Paragraph 0091, Ziemer states that the embodiment shown in FIG. 13A (relied on by the

Appl. No. 10/786,639  
Reply to Office Action dated March 29, 2005  
Page 5

Examiner) is the same as the embodiment shown in FIG. 10A (paragraph 0081/US 2004/0097324) with the addition of the shifting element C to provide the ten forward speed ratios. The element C is added to selectively connect the sun gear 41 of the second rear-mounted planetary gear set NS2 with ground. In FIG. 10A, which went un-cited by the Examiner, Ziemer describes his planetary arrangement as including a "first non-shiftable front-mounted planetary gear set VS1, two shiftable rear-mounted planetary gear sets NS1 and NS2" (emphasis added). At paragraph 0082, Ziemer describes the planetary gear set NS1 as having a carrier 35, a sun gear 31 and a ring gear 33, and describes the planetary gear set NS2 as having a carrier 45, a ring gear 43, and sun gear 41. Thus, the planetary arrangement NS has two planetary gear sets with two sun gears, two ring gears and two carrier assemblies. Obviously, Ziemer sets forth that he has three planetary gear sets and sets forth the ratio of each of the three planetary gearsets in FIG. 13B ( $VS=1.65$ ,  $NS1=2.30$ ,  $NS2=3.00$ ). This disclosure is in conflict with the Examiner's analysis. The disclosure by the inventor, who is presumed skilled in the art, should take precedence. Ziemer has three planetary gearsets and seven torque transmitting mechanisms and therefore cannot possibly satisfy § 102 as an anticipatory reference since he does not use the same elements used in exactly the same situation and united in the same way to perform the identical function as the present invention.

In view of the above amendments and remarks, this application is believed to be in condition for allowance, which is herewith respectfully requested.

Respectfully submitted,



Donald F. Scherz, Attorney  
Reg. No. 24,539  
810-953-9268